


PATENT
Attorney Docket No. 28655/37222

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Alexander M. Rothacker)	I hereby certify that this paper is being
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Filed: August 21, 2001)	Patents, P.O. Box 1450, Alexandria,
)	VA 22313-1450 on: May 25, 2005
For: Incremental Weight Training System, Apparatus, and Methods)	
)	Patrick D. Ertel, Reg. No. 26,877
Group Art Unit: 3764)	Attorney for Applicant
Examiner: Tam M. Nguyen)	

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The applicant hereby requests that a panel of examiners formally review the legal and factual bases of the rejections in the above-referenced application, prior to the filing of an appeal brief. The applicant respectfully submits that the rejections are legally and factually inadequate, for the reasons concisely described herein. Submitted herewith is a Notice of Appeal.

Claims 4-6, 8-11, and 15-20 are pending and at issue. Claims 4-6 and 15-20 have been rejected as obvious over U.S. Patent No. 3,825,253 to Speyer ("Speyer") in view of U.S. Patent No. 4,685,675 to Heiman ("Heiman"), U.S. Patent No. 6,193,635 to Webber *et al.* ("Webber"), U.S. Patent No. 4,971,305 to Rennex ("Rennex"), U.S. Patent No. 4,602,788 to Wendt (hereafter "Wendt"), and the Choice1 Medical Distributors website advertisement "Hausmann Pulley Weights: Extra 2 lb Weight Plate" (hereafter, "Choice1"). Claims 8-11 have been rejected as obvious over Webber in view of Heiman, Rennex, Wendt, and Choice1.

The obviousness rejections are legally and factually inadequate because a proper obviousness analysis was not performed with respect to the recited incremental weight training apparatus and method of incrementally increasing a person's strength

by incrementally increased weight training. In particular, the Office has not identified legally sufficient motivation to combine the cited references, as proposed.

THE CLAIMED INVENTION

For many years, the conventional wisdom in weight training could accurately be summarized by the phrase “no pain, no gain.” Today, however, it is generally understood that the wisdom espoused by this alleged axiom is inaccurate. Notwithstanding the present recognition that ‘pain’ may, in fact, preclude ‘gain,’ conventional weight lifting systems typically use weights of at least one and one quarter pound increments. Such increments represent substantial increases in exercise resistance and can therefore cause weight lifters to suffer injuries. *See* application at page 5, lines 2-14. Further, such increments can cause weight lifters to encounter plateaus in their weight training programs. *See* application at page 6, lines 3-12.

The claimed invention addresses these problems by providing an incremental weight system that combines *at least one very light incremental weight* from a group of incremental weights including a one quarter-ounce weight, a one half-ounce weight, a one-ounce weight, and a two-ounce weight with *a weight training apparatus* such as (1) a standard barbell and set of free weights or (2) a cable-type weight training apparatus. “While it may seem insignificant to increase exercise intensity between workouts by a one-ounce increment, over the course of a year, a continuous one-ounce increase in exercise intensity in a three day per week workout program results in a total exercise intensity increase of nine and three quarter pounds.” *See* application at page 5, lines 24-30. Thus, the claimed invention is advantageous in that it allows weight lifters to make continuous incremental gains in strength by incrementally increasing starting resistances while diminishing the risk of failure or injury (relative to existing weight training methods).

THE CITED REFERENCES DO NOT DISCLOSE OR SUGGEST THE CLAIMED INVENTION

The cited references, whether taken alone or in any proper combination, fail to disclose or suggest a *weight training apparatus* such as a standard barbell and set of free weights or a cable-type weight training apparatus *in combination* with *at least one very small incremental weight* from a group of incremental weights including a one quarter-ounce weight, a one half-ounce weight, a one-ounce weight, and a two-ounce weight, as recited by all pending claims 4-6, 8-11, and 15-20.

Speyer merely discloses a weight training apparatus comprising a barbell and a set of free weights including a centrally disposed bore and a slot. Speyer does not disclose or suggest combining such a weight training apparatus with *at least one very small incremental weight*, as recited by all pending claims 4-6, 8-11, and 15-20.

Heiman discloses an adjustably weighted racquet including a plurality of individual weights, which can be removably inserted into bores disposed about an exterior of the racquet frame. Heiman is entirely unrelated to weight training/bodybuilding, is not reasonably pertinent to the particular problem with which the inventor was concerned, and therefore constitutes non-analogous art, which cannot be utilized in an obviousness rejection. In re Oetiker, 24 U.S.P.Q.2d 1443, 1445 (Fed. Cir. 1992). To the extent that Heiman is available as a reference in an obviousness rejection, it merely provides a tennis racquet which "permits variation in distribution and weighting by the user." *See* Heiman at column 2, lines 5-6. Notwithstanding its disclosure of 1/8 ounce weights, Heiman does not disclose or suggest any advantage whatsoever that relates to the use of such a small incremental weight in combination with a weight training apparatus, as claimed. Moreover, Heiman only contemplates *varying a single starting weight resistance* with the 1/8 ounce weights. In contrast, the claimed invention provides an incremental weight training apparatus that permits *continuous incremental gains* to be made without injury or failure because the starting resistances of the weight training apparatus used in combination therewith can be varied by (1) selecting the starting weight training resistance on one of a standard barbell and set of free weights or a cable-type weight training apparatus and (2) adding at least one very small incremental weight thereto.

Webber merely discloses a standard cable-type weight training apparatus and a set of plate/weights of standard increments such as 5 pounds, 10 pounds, etc. *See* Webber at column 6, lines 14-17. Webber also generally discloses add-on plates "in various incremental weights of 5 lbs or less." *See* Webber at column 6, lines 43-44. The examiner's contention that this disclosure "clearly covers the instant invention's range of incremental weights" is legally incorrect. *See* Final Action dated January 25, 2006 at page 2. One of ordinary skill would not be motivated to combine at least one incremental weight from a group of incremental weights including a one quarter-ounce weight, a one half-ounce weight, a one-ounce weight, and a two-ounce weight

in combination with a cable-type weight training apparatus, as claimed, based on the generic disclosure of add-on plates "in various incremental weights of 5 lbs or less."

Rennex discloses "a device which enables weight trainers to more conveniently select a particular weight and to make this weight selection with smaller weight increments than heretofore has been possible." *See* Rennex abstract. Rennex discloses increments with the smallest being 0.2 pounds (*i.e.*, 3.2 ounces). *See* Rennex at column 3, lines 10-12 and 40-43. The *smallest* increment in Rennex is more than one and one-half times the *largest* increment recited in independent claims 4, 8, and 15. Moreover, the present application specifically discloses that one-half ounce to one-ounce incremental gains should be made between workouts for "for smaller muscle groups, such as, for example, forearm, hand, and triceps." Similarly, the present application discloses that children and persons affected by existing injuries should make relatively small gains between workouts. *See* application at page 9, line 36 – page 10, line 4. Notably, Rennex does not provide a system where such small incremental gains can be made.

Further, notwithstanding its disclosure of increments as small as 0.2 pounds, *Rennex does not disclose any advantage* that is *specific* to such a small increment relative to a larger increment. Thus, Rennex does not disclose or suggest any motivation for using at least one very small incremental weight in combination with a weight training apparatus such as a standard barbell and set of free weights or a cable-type weight training apparatus, as claimed. And it most certainly does not disclose or suggest a group of incremental weights of one quarter-ounce, one half-ounce, one-ounce, and two-ounces as recited by all claims.

Wendt discloses a weighted golf swing exercise club including a set of circular disks comprising one-ounce, two-ounce, four-ounce, eight-ounce, and sixteen-ounce weights. *See* Wendt at column 2, lines 36-40. Wendt is directed to "improving a golf swing." *See* Wendt abstract. Thus, Wendt is entirely unrelated to weight training/bodybuilding, is not reasonably pertinent to the particular problem with which the inventor was concerned, and therefore constitutes non-analogous art, which cannot be utilized in an obviousness rejection. *In re Oetiker, supra*. To the extent that Wendt is available as a reference in an obviousness rejection, it merely provides a single golf club shaft for use in conjunction with the series of weighted disks. Wendt does not disclose or suggest any advantage whatsoever that relates to the use of such a

small incremental weight in combination with a weight training apparatus and the weights used in conventional weight training methods, as claimed. Further, similar to Heiman (above), Wendt only discloses and contemplates *varying a single starting weight resistance* with the weighted disks, the *smallest* of which is four times greater than the smallest increment recited in independent claims 4, 8, and 15.

Finally, Choice1 merely discloses a two pound plate and, thus, does not disclose or suggest a weight training apparatus in combination with at least one very small incremental weight, as recited by all claims.

For a *prima facie* case of obviousness to be established, the teachings from the prior art itself must appear to have suggested the claimed subject matter to one of ordinary skill in the art. *See In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976). The mere fact that the prior art could be modified as proposed by the examiner is not sufficient to establish a *prima facie* case of obviousness. *See In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). The examiner has not established that the cited documents themselves would have indicated to one of ordinary skill in the art that the (alleged) various incremental weights disclosed by Rennex or Webber in combination with Speyer's barbell and set of free weights or Webber's standard cable-type weight training apparatus would provide a benefit to a user. Thus, the record indicates that the examiner combined the references using the appellants' disclosure as a template, which is improper. *See Fritch*, 972 F.2d at 1266, 23 USPQ2d at 1784. Accordingly, the claim rejections should be reversed.

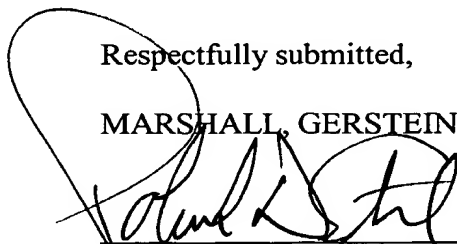
CONCLUSION

In view of the foregoing, it is respectfully submitted that the application should be allowed.

May 25, 2005

Respectfully submitted,

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